



UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*Eol*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/265,926	03/11/99	DALES	J P30920

HM12/0904  
SMITHKLINE BEECHAM CORPORATION  
CORPORATE INTELLECTUAL PROPERTY-UW2220  
P O BOX 1539  
KING OF PRUSSIA PA 19406-0939

EXAMINER
----------

BERCH, M

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED:

*19*  
09/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Advisory Action**

Application No.

09/265,926

Applicant(s)

DALES, JOHN ROBERT  
MANSFIELD

Examiner

Mark L. Berch

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 August 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 21 August 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See memo.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 5-7, 10-14, 21.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Mark L. Berch  
Primary Examiner  
Art Unit: 1624

### DETAILED ACTION

Applicants' traverse is unpersuasive.

Applicants state that the examiner is using "Applicants' own disclosure as a guide". That is manifestly not the case. The reasoning presented in e.g. the Final Rejection makes no reference whatsoever to the disclosure.

With regard to R<sub>3</sub>, applicants state that "For the final compound ... amino is clearly preferred – in fact it is required..." Agreed, and that is the basis for the examiner's assertion. Applicants rebut by pointing out that page 7, lines 12-13 list other choices, and indeed, 6 other choices are named in addition to amino. Agreed, but the examiner was not saying that amino was the sole choice, but rather that the reference (and not applicants' specification) indicates that it is preferred.

With regard to R<sub>1</sub>, applicants reasoning is not agreed with. Methyl and ethyl are the only ones actually names.

Applicants point that the reference teaches for R<sub>2</sub> "substantially more than two possibilities" is not quite understood. The examiner notes that it could be considered as 3 or 6, and that 3 are specifically named.

Further, even if there are 7 named choices, not 1, that would give , using the named choices (without any reference to preference) for R<sub>1</sub>, R<sub>2</sub>, and R<sub>3</sub>,  $2 \times 3 \times 7 = 42$ , clearly small enough to anticipate.

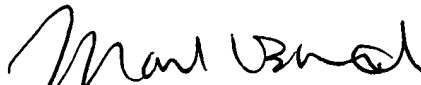
With regard to the obviousness rejection, an impasse has clearly been reached. As a legal matter, applicants must compare to the prior art process. As set forth in the paper of 8/16/00, there were very substantial differences in how the prior art process was done and its "replication" in the declaration. There were four differences

Art Unit: 1624

(D, E, F, and G) just in the reduction step alone, e.g. very different solvent and temperature were used. These failures to replicate the prior art resulted in a product which could not be crystallized from n-butanol, whereas the prior art process did get a product which could be crystallized from n-butanol. This shows clearly that the numerous changes introduced by the declarant resulted in a product inferior to the actual prior art product. In addition, the examiner explained that the version of the claimed process in the declaration does not even fall within claim 10 (the process in the declaration involved a transesterification. No such transesterification appears in either the claims or the prior art). At any rate, pages 3-6 of that action explain in complete detail the flaws in the declaration, and hence it cannot be relied on. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.

  
Mark L. Berch  
Primary Examiner  
Art Unit 1624

August 30, 2001